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EXAMINER

NGUYEN, TRI V

ART UNIT PAPER NUMBER

1751

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/966,026	Applicant(s) NIELSEN, PAUL	
	Examiner Tri V. Nguyen	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. In the amendment filed on July 19, 2006, Claims 1, 2, 9, 16, 17, 21, 22, 26 and 29 have been amended. The currently pending claims considered below are Claims 1-29.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 22 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13 and 14 of copending Application No. 10/101,581. Although the conflicting claims are not identical, they are not patentably distinct from each other because a data warehouse operable to receive data from a network is recited in both applications (an automated teller machine is treated as a self-service terminal).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 9 and 16 recite the limitation "and/or" which renders the claim unclear. Claims 2-8, 10-15 and 17-21 are dependent claims of Claims 1, 9 and 16 respectively; thus they inherit the same deficiencies as Claims 1, 9 and 16.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, 4, 7-9, 11, 14-17, 19-22, 24-29 are rejected under 35 U.S.C. 102(e) as being anticipated by De Leo et al. (6,381,626).

Claim 1: De Leo et al. discloses a method of selecting advertisements for display on or adjacent to a plurality of self-service terminals comprising the steps of:

- (a) collecting environment data related to the environment of each terminal including the nature of businesses nearby the terminal (col 6, lines 42-65; col 7, line 23 to col 8, line 4 and col 8, lines 24-43);
- (b) collecting transaction data indicating the type and time of transactions carried out at the terminal (col 5, lines 43 to col 6, line 6); and
- (c) storing the collected data in a data warehouse (col 6, lines 42-65; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 2: De Leo et al. discloses a method according to claim 1, further comprising the step of:

(d) collecting advertising data which describes the type and content of one or more advertisement displayed on or adjacent to the terminal at particular times (col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 4: De Leo et al. discloses a method according to claim 1, wherein the data is collected and stored in real time or near real time (col 5, line 43 to col 6, line 6; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 7: De Leo et al. discloses a method according to claim 2, further comprising the steps of

(e) querying the data warehouse to determine which terminals are located on sites at which a selected business activity is carried out (col 6, lines 7 - 22; col 6, lines 42- 65 and col 8, lines 24 - 43); and

(f) selecting an advertisement for display which includes content related to that business activity (col 5, lines 19 - 42).

Claim 8: De Leo et al. discloses a method according to claim 2, further comprising the steps of:

(e) querying the data warehouse to calculate a statistical distribution of the frequency of different transactions occurring at a terminal (col 5, lines 19-60 and col 6, lines 7 - 22); and

(f) selecting an advertisement for display at the terminal dependent on the statistical distribution (col 5, lines 19-60 and col 6, lines 7 - 22).

Claim 9: De Leo et al. discloses a method of selecting advertisements for display on or adjacent to a plurality of self-service terminals comprising the steps of:

(a) collecting environment data related to the environment of each terminal including the nature of businesses nearby the terminal (col 6, lines 42-65; col 7, line 23 to col 8, line 4 and col 8, lines 24-43);

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(b) collecting advertising data related to the type and content of one or more advertisement displayed on or adjacent to the terminal at particular times(col 5, line 43 to col 6, line 6; col 6, lines 42-65; col 7, line 23 to col 8, line 4 and col 8, lines 24-43); and
(c) storing the collected data in a data warehouse (col 6, lines 42-65; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 11: De Leo et al. discloses a method according to claim 9, wherein the data is collected and stored in real time or near real time (col 5, line 43 to col 6, line 6; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 14: De Leo et al. discloses a method according to claim 9, further comprising the steps of

(d) querying the data warehouse to determine which terminals are located on sites at which a selected business activity is carried out (col 6, lines 7 - 22; col 6, lines 42- 65 and col 8, lines 24 - 43); and
(e) selecting an advertisement for display which includes content related to that business activity (col 5, lines 19 – 42).

Claim 15: De Leo et al. discloses a method according to claim 9, further comprising the steps of:

(d) querying the data warehouse to calculate a statistical distribution of the frequency of different transactions occurring at a terminal (col 5, lines 19-60); and
(e) selecting an advertisement for display at the terminal dependent on the statistical distribution (col 5, lines 19-60 and col 6, lines 7 - 22).

Claim 16: De Leo et al. discloses a data warehouse operable to receive data from a network of self-service terminals comprising:

(a) means for holding environment data related to the environment of each terminal including its location and the nature of a business nearby the terminal (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43);

(b) means for holding transaction data indicating the type and time of transactions carried out at the terminal (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43); and

(c) the data warehouse being operable to provide information in real time or near real time for selecting advertisements for display on or adjacent to one or more of the plurality of self-service terminals (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 17: De Leo et al. discloses a data warehouse according to claim 16, further comprising means for holding advertising data indicating the type and content of one or more advertisement displayed on or adjacent to the terminal at particular times (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 19: De Leo et al. discloses a data warehouse according to claim 16, further comprising means for determining which terminals are located on or within a predetermined distance of sites at which a selected business activity is carried out (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 7 - 22; col 6, lines 42 - 65; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 20: De Leo et al. discloses a data warehouse according to claim 17, further comprising means for calculating a statistical distribution of the frequency of different transactions occurring at a terminal and selecting an advertisement for display at the terminal dependent on the statistical distribution (col 5, lines 19-60 and col 6, lines 7 - 22).

Claim 21: De Leo et al. discloses a data warehouse according to claim 16, further comprising means for determining which transactions occur at one or more terminal within a predetermined time period of a public event or a sporting event (col 5, lines 20-43).

Claim 22: De Leo et al. discloses a data warehouse operable to receive data from a network of self-service terminals comprising:

(a) means for holding environment data which describes the environment of each terminal including data indicating its location or the nature of a business nearby the terminal (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43);

(b) means for holding advertising data related to the type and content of one or more advertisement displayed on the terminal or adjacent the terminal at particular times (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43); and

(c) the data warehouse being operable to provide information in real time or near real time for selecting advertisements for display on or adjacent to one or more of the plurality of self-service terminals (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 24: De Leo et al. discloses a data warehouse according to claim 22, further comprising means for determining which terminals are located on or within a predetermined distance of sites at which a selected business activity is carried out (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 25: De Leo et al. discloses a data warehouse according to claim 22, further comprising means for calculating a statistical distribution of the frequency of different transactions occurring at a terminal and selecting an advertisement for display at the terminal dependent on the statistical distribution (col 5, lines 19-60 and col 6, lines 7 - 22).

Claim 26: De Leo et al. discloses a data warehouse according to claim 22, further comprising means for determining which transactions occur at one or more terminal within a predetermined time period of a public event or a sporting event (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col

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8, lines 24-43).

Claim 27: De Leo et al. discloses a self-service terminal comprising:

- (a) display means for displaying advertising material (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43);
- (b) network connection means for coupling the terminal to a self-service network (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43);
- (c) means for receiving commands from the network which determine what advertising content is to be displayed on the display means and at what time (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43); and
- (d) means for sending information to the network which identifies which transactions are occurring at the terminal and at what time they occur (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 28: De Leo et al. discloses a self-service terminal according to claim 27, further comprising means for sending information to the network which explicitly identifies what advertising material was displayed on the display means during a transaction at the terminal (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim 29: De Leo et al. discloses a method of analyzing a self-service network comprising the steps of:

- (a) holding in a database data describing transactions performed by a terminal in the network and advertising content displayed on or adjacent the terminal substantially at the time of the transaction (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43);
- (b) gathering terminal data from terminals in the network which describes transactions performed by each terminal in the network and respective advertising content displayed on or adjacent each terminal (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43);

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- (c) entering the terminal data into the database (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43); and
- (d) analyzing the terminal network by querying the data in the database (col 3, lines 22-50; col 5, line 43 to col 6, line 6, col 6, lines 23 - 41; col 7, line 23 to col 8, line 4 and col 8, lines 24-43).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 5, 6, 10, 12, 13, 18 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Leo et al. in view of Calvey ("For banks, ATM advertising could be right on the money" in San Francisco Business Times).

Claim 3: De Leo et al. discloses a method according to claim 1, but does not explicitly recites wherein the plurality of terminals are distributed across more than one deployer network. In an analogous art, Calvey teaches that it is known to use more than one deployer network as set forth in page 1, § 3 and 4 to reach a greater number of users. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by De Leo et al., with the distribution across more than one deployer network as taught by Calvey. One would have been motivated to modify the method of De Leo et al. to reach a greater audience of users that frequent different deployer network.

Claim 5: De Leo et al. discloses a method according to claim 2, but does not explicitly recites further comprising the step of:

(e) querying the data warehouse to determine the relationship between the effectiveness of an advertisement and the terminal on or adjacent which it is displayed. In an

analogous art, Calvey teaches that it is known to determine the relationship between the effectiveness of an advertisement and the terminal on or adjacent which it is displayed as set forth in page 2, § 8 and 9 to better estimate the efficiency of the advertisement shown. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by De Leo et al., with the determination of the relationship between the effectiveness of an advertisement and the terminal on or adjacent which it is displayed as taught by Calvey. One would have been motivated to modify the method of De Leo et al. to better estimate the efficiency of the advertisement shown thus allowing for improvements in the marketing scheme and maximizing profitability.

Claim 6: De Leo et al. discloses a method according to claim 5, but does not explicitly recites wherein the effectiveness of an advertisement is measured by determining how often the display of an advertisement on or adjacent a terminal is substantially coincident with a transaction which is related to the advertising content, being initiated by a user at that terminal. De Leo et al. teaches the variables of the frequency of the display of an advertisement, the content of the advertisement and the timing during the day (col 5, lines 19 – 43). In an analogous art, Calvey teaches that it is known to determine the effectiveness of displaying advertising material as set forth in page 1, § 8 and 9 to better estimate the efficiency of the advertisement shown. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by De Leo et al., with measuring the effectiveness of displaying advertisements as taught by Calvey. One would have been motivated to modify the method of De Leo et al. to better estimate the efficiency of the advertisement shown thus allowing for improvements in the marketing scheme and maximizing profitability.

Claim 10: De Leo et al. discloses a method according to claim 9, but does not explicitly recites wherein the plurality of terminals are distributed across more than one deployer network. In an analogous art, Calvey teaches that it is known to use more than one deployer network as set forth in page 1, § 3 and 4 to reach a greater number of users. Therefore, it would have been obvious to one having ordinary skill in the art at the time

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the invention was made to modify the method as taught by De Leo et al., with the distribution across more than one deployer network as taught by Calvey. One would have been motivated to modify the method of De Leo et al. to reach a greater audience of users that frequent different deployer network.

Claim 12: De Leo et al. discloses a method according to claim 9, but does not explicitly recites further comprising the step of:

(d) querying the data warehouse to determine the relationship between the effectiveness of an advertisement and the terminal on or adjacent which it is displayed. In an analogous art, Calvey teaches that it is known to determine the relationship between the effectiveness of an advertisement and the terminal on or adjacent which it is displayed as set forth in page 2, § 8 and 9 to better estimate the efficiency of the advertisement shown. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by De Leo et al., with the determination of the relationship between the effectiveness of an advertisement and the terminal on or adjacent which it is displayed as taught by Calvey. One would have been motivated to modify the method of De Leo et al. to better estimate the efficiency of the advertisement shown thus allowing for improvements in the marketing scheme and maximizing profitability.

Claim 13: De Leo et al. discloses a method according to claim 12, but does not explicitly recites wherein the effectiveness of an advertisement is measured by determining how often the display of an advertisement on or adjacent a terminal is substantially coincident with a transaction which is related to the advertising content, being initiated by a user at that terminal. De Leo et al. teaches the variables of the frequency of the display of an advertisement, the content of the advertisement and the timing during the day (col 5, lines 19 – 43). In an analogous art, Calvey teaches that it is known to determine the effectiveness of displaying advertising material as set forth in page 1, § 8 and 9 to better estimate the efficiency of the advertisement shown. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by De Leo et al., with measuring the effectiveness of displaying advertisements as taught by Calvey. One would have been motivated to

modify the method of De Leo et al. to better estimate the efficiency of the advertisement shown thus allowing for improvements in the marketing scheme and maximizing profitability.

Claim 18: De Leo et al. discloses a data warehouse according to claim 17, but does not explicitly recites further comprising means for determining how often the display of an advertisement on or adjacent a terminal is substantially coincident with a transaction which is related to the advertising content, being initiated by a user at that terminal. De Leo et al. teaches the variables of the frequency of the display of an advertisement, the content of the advertisement and the timing during the day (col 5, lines 19 – 43). In an analogous art, Calvey teaches that it is known to determine the effectiveness of displaying advertising material as set forth in page 1, § 8 and 9 to better estimate the efficiency of the advertisement shown. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by De Leo et al., with measuring the effectiveness of displaying advertisements as taught by Calvey. One would have been motivated to modify the method of De Leo et al. to better estimate the efficiency of the advertisement shown thus allowing for improvements in the marketing scheme and maximizing profitability.

Claim 23: De Leo et al. discloses a data warehouse according to claim 22, but does not explicitly recites further comprising means for determining how often the display of an advertisement on or adjacent a terminal is substantially coincident with a transaction which is related to the advertising content, being initiated by a user at that terminal. De Leo et al. teaches the variables of the frequency of the display of an advertisement, the content of the advertisement and the timing during the day (col 5, lines 19 – 43). In an analogous art, Calvey teaches that it is known to determine the effectiveness of displaying advertising material as set forth in page 1, § 8 and 9 to better estimate the efficiency of the advertisement shown. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by De Leo et al., with measuring the effectiveness of displaying advertisements as taught by Calvey. One would have been motivated to modify the

method of De Leo et al. to better estimate the efficiency of the advertisement shown thus allowing for improvements in the marketing scheme and maximizing profitability.

Response to Arguments

9. Applicant's arguments filed July 19 2006 have been fully considered but they are not persuasive.

A. Claim 1: The applicant argues that De Leo et al. do not show "collecting environment data" (page 11, last line). The Examiner respectfully disagrees as De Leo et al. recites a configuration file and a play log that are used in the process of providing ads to a terminal based on features such as the time of day, the surrounding business and the type of transactions (col 5, lines 19-60 and col 8, lines 29-43). For example, since the ads are tailored to a specific time of the day, the time stamp is seen as an environment data. Furthermore, De Leo et al. recites "the play log can include detailed reporting regarding each transaction message including time, location" (col 8, lines 34-36).

B. Claims 2 and 17: The applicant argues that De Leo et al. do not show "collecting environment data which describes the type and content" of the ads (page 13). First, the Examiner notes that the limitation of the claim has been changed stemming from the amendment. However responding to the argument which is in part pertinent to the present claim, the Examiner respectfully disagrees as De Leo et al. recites a play log "can include detailed reporting regarding each transaction message including time, location" (col. 8, lines 34-36).

C. Claims 3, 5, 6 and 12: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be

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established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both De Leo et al. and Calvey are directed to advertisement on an ATM network. De Leo et al. teach the feature of the deployment across "network affiliation" or bank association (col 5, lines 1-7). Calvey reinforces this point by mentioning specific network advertisements. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In response to the Applicant's arguments concerning the effectiveness measurement of the advertisement and statistical distribution, the Examiner notes that the querying the data warehouse is a critical and obvious step since data such as at least the identities of the advertisement provided are needed. Additional properties such as frequency, date, customers identities are present in the "play log" disclosed by De Leo et al. Regarding the motivation statement, the Examiner notes that evaluating a response is a key component of any marketing campaign.

D. Claim 4: The applicant argues that De Leo et al. do not show "real time" (page 14). The Examiner respectfully disagrees as De Leo et al. teaches the use of advertising

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targeted to specific transactions; thus, the collection of data is deemed to be in "real-time" (col 5, lines 44 to col 6, line 7).

E. Claim 7: The applicant argues that De Leo et al. do not show "which terminals are located at which selected business activity is carried out" (page 15) and "the data warehouse" (page 16). The Examiner respectfully disagrees as De Leo et al. show that data are collected thus inferring a data warehouse and ads are provided that are targeted to the specific location and surrounding business (for example the ad showing at noon for a local fast food establishment).

F. Claim 8: The applicant argues that De Leo et al. do not show "statistical distribution" (page 17) and "selecting an advertisement" based on the "statistical distribution" (page 18). The Examiner respectfully disagrees as De Leo et al. teach the feature of showing the ads based on the time of the day such as the ads promoting a movie are shown in the period 4 PM to 8 PM. Furthermore, a statistical distribution can be understood as being 1 thus the selection of the ad based on the type of transaction as taught by De Leo et al. is commensurate with the limitation of claim 8.

G. Claim 9: The applicant argues that De Leo et al. do not show the collection of "environment data" (page 19). The Applicant is directed to the response in part A regarding the collection of data.

H. Claim 16: The applicant argues that De Leo et al. do not show "real time" (page 20). The Examiner respectfully notes that the claim language is "in real time **or near real time**" (emphasis added by the Examiner) with "near real time" being defined in the specification as "possibly with a lag of a few hours" (page 2, line 22).

I. Claim 21: The applicant requests a further identification of the passage relied upon for the rejection (page 22). The Examiner notes all transactions are recorded and time

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stamped as in any ATM transaction. De Leo et al. disclose that the advertisement being provided to the user of the ATM at a predetermined time (4PM to 8PM) of a public event (movie).

J. Claims 27, 28 and 29: The applicant argues that De Leo et al. do not show "means for sending information to the network which identifies which transactions are occurring at the terminal and at what time they occur" (page 22). The Examiner respectfully disagrees as De Leo et al. an ATM (which is the self-service terminal of the present claim) which in order to function has to be connected to a banking network for the transactions to occur and be recorded. Furthermore, De Leo et al. teach how the advertisement is displayed while during the transaction and the feature of a "play log."

Conclusion

10. THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029 and Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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